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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/538,168	04/08/2006	Markus Anliker	TME-2217	2243
24131 7590 02/15/2011 LERNER GREENBERG STEMER LLP P O BOX 2480 HOLLYWOOD, FL 33022-2480				
EXAMINER				
CHU, KING M				
ART UNIT		PAPER NUMBER		
3788				
MAIL DATE		DELIVERY MODE		
02/15/2011		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/538,168

Applicant(s)

ANLIKER, MARKUS

Examiner

KING M. CHU

Art Unit

3788

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4 and 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-940)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. In view of the Appeal Brief filed on 09/27/2010, **PROSECUTION IS HEREBY REOPENED**. New grounds of rejections are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

Drawings

2. The subject matter of this application admits of illustration by a drawing to facilitate understanding of the invention. Applicant is required to furnish a drawing under 37 CFR 1.81(c). No new matter may be introduced in the required drawing. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). Currently there are NO drawings filed on record.

Claim Rejections - 35 USC § 112

3. Claims 1, 4 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In reference to Claim 1, Applicant recites "a package having a chamber formed therein, said chamber containing a suppository therein, said package having a second chamber formed therein, said second chamber being separate from said chamber and disposed within said chamber, and said other second chamber containing a lubricant therein." It is unclear structurally as to how the second chamber is related to the initial primary chamber. From the claims, the second chamber is formed within the primary chamber therefore the second chamber CANNOT be separate from the primary chamber.

Claim 1 recites the limitation "said chamber" in line 6 and line 2 of Claim 20. It is unclear whether these limitations are referring to a chamber or a second chamber. Clarification is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Voss (3,667,465) in view of Gordon et al. (Gordon 3,967,728).

In reference to Claim 1

In Figure 2, Voss discloses a suppository package comprising: a package (20) having a chamber formed therein (interior of package 20), said chamber containing a suppository therein (16) as well as lubricant (col. 4, ll. 31-35).

Voss discloses the claimed invention as discussed above with the exception of the following claimed limitations that are taught by Gordon: a second chamber (33 of pouch 17 that is part of package 11) formed therein, said second chamber being separate from said chamber (see Figure 1-3 where 17 is separate from a main chamber, which is located at 11) and disposed within said chamber, and said second chamber containing a lubricant therein (col. 2, ll. 33-35).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Voss in view of Gordon so that a second chamber of Gordon is provided within a primary package of Voss since catheters or suppositories are preferably lubricated prior to introduction into the patient and the secondary chamber of lubricant allows automatic lubrication when the secondary chamber's seal is broken (col. 1 ll. 17-19 and col. 3, ll. 27-29) as well as providing a sterile agent for a packaged device readily available for sterilization, as taught by Gordon (col. 1, ll. 27-30 and col. 2, ll. 33-35). Further, it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *In re Dulberg*, 289 F.2d 522, 523, 129 USPQ 348, 349 (CCPA 1961).

In reference to Claim 20

Voss in view of Gordon discloses the claimed invention as discussed above for claim 1 and Gordon further teaches that the chamber and said second chamber are capable of being opened simultaneously (when pouch 17 is breached at 26, both chambers are opened to one another).

5. Claim 4 rejected under 35 U.S.C. 103(a) as being unpatentable over Voss (3,667,465) in view of Gordon et al. (Gordon 3,967,728) and further in view of Davidowitz (3,712,300).

In reference to Claim 4

Voss in view of Gordon discloses the claimed invention as discussed above for claim 1 with the exception of the following claimed limitations that are taught by Davidowitz: a suppository package that contains a lubricant that is a greasy ointment or Vaseline (see column 5, lines 67-68).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Voss in view of Gordon and further in view of Davidowitz so that Vaseline is used as a lubricant in order to reduce friction when the suppository is used, as taught by Davidowitz (col. 5, ll. 67-68).

Response to Arguments

6. Applicant's arguments with respect to claim 1 have been fully considered but are moot in view of the new ground(s) of rejection. Gordon fully teaches the provision of an enclosed secondary chamber for storage of a lubricant.

This action is made Non-Final in view of Applicant's Appeal Brief.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KING M. CHU whose telephone number is (571)270-7428. The examiner can normally be reached on Monday - Friday 9AM - 6PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ehud Gartenberg can be reached on (517)272-4828. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/KING M CHU/
Examiner, Art Unit 3788

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/J. Gregory Pickett/
Acting SPE, Art Unit 3788